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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,932	03/30/2004	Peter E. Hart	20412-08383	7930
758	7590	09/27/2006	EXAMINER	
FENWICK & WEST LLP SILICON VALLEY CENTER 801 CALIFORNIA STREET MOUNTAIN VIEW, CA 94041			THOMPSON, JAMES A	
			ART UNIT	PAPER NUMBER
			2625	

DATE MAILED: 09/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action Before the Filing of an Appeal Brief</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/814,932	HART ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	James A. Thompson	2625

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 18 September 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1.  The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a)  The period for reply expires 3 months from the mailing date of the final rejection.
- b)  The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2.  The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3.  The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a)  They raise new issues that would require further consideration and/or search (see NOTE below);
  - (b)  They raise the issue of new matter (see NOTE below);
  - (c)  They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d)  They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attached. (See 37 CFR 1.116 and 41.33(a)).

4.  The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5.  Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
6.  Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7.  For purposes of appeal, the proposed amendment(s): a)  will not be entered, or b)  will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1-49.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

#### AFFIDAVIT OR OTHER EVIDENCE

8.  The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9.  The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10.  The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11.  The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
12.  Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.
13.  Other: \_\_\_\_\_.

**DETAILED ACTION**

***Response to Amendment***

1. The proposed amendments to the claims change the overall scope of the claims, thus necessitating further consideration and further search. Additionally the proposed additions of claims 52-55 have been made without canceling a corresponding number of finally rejected claims. Therefore, the **proposed amendments to the claims are not entered.**

***Response to Arguments***

2. Applicant's arguments filed 18 September 2006 have been fully considered but they are not persuasive.

**Regarding page 11, lines 3-20:** As stated above, the proposed amendments to the claims and the proposed new claims would require further consideration and further search, and the new claims have been proposed without canceling a corresponding number of finally rejected claims. Therefore, the proposed amendments have not been entered.

**Regarding page 11, line 21 to page 13, line 9:** In the previous office action, dated 06 July 2006 and mailed 12 July 2006, Examiner clearly stated that the motivation for combining the references as set forth in the arguments regarding claims 1 and 41 "would have been to be able to automatically control the routing and processing of documents that are converted into digital format (para. 9, lines 1-8 of Constantin [US PGPub 2003/0002068 A1]), which is clearly advantageous over having to manually control the digital data input." Applicant incompletely quotes the portion of Constantin cited by Examiner. Paragraph 9 of Constantin states: "The present invention is

directed to a flexible method and apparatus for control of the routing and processing of documents by a document-receiver. The sender need not know how the receiver classifies the document sent to him or anything about how the receiver intends to route or process the document. The document-receiver may easily establish and change document classifications and document routing and processing instructions." This cite from Constantin clearly and unambiguously supports Examiner's first stated motivation to combine Constantin with Sugiyama (US Patent 5,633,723). This automatic routing control and document processing is clearly advantageous over slow, manual routing control and document processing and would readily have been recognized by one skilled in the art to be an advantage to combining the teachings of Constantin with Sugiyama.

Secondly, the additional suggestion to combine the references states that a "further suggestion for combining would have been that the interface of Sugiyama requires a video signal input in order to have data upon which to operate. The printing sub-system of Constantin simply provides the required video signal." In other words, one of ordinary skill in the art would immediately recognize that some digital input is necessary for the system of Sugiyama to function, and Sugiyama does not go into extensive detail about the input data. Thus, in light of the first motivation given, one of ordinary skill in the art at the time of the invention would have recognized the additional need to provide an input for the system of Sugiyama. Coupled with the fact that Constantin also performs automated routing and document processing, one of ordinary skill in the art at the time of the invention would clearly have seen that

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Constantin is a reference well-suited for combination with Sugiyama.

Finally, the Federal Circuit Court has held that "There are three possible sources of motivation to combine the references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art" [*In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ 2d 1453, 1457-58 (Fed. Cir. 1998)] and this is still the standard used in determining motivation/suggestion to combine references in an obviousness rejection [see MPEP §2143.01.I]. Examiner has provided motivation and suggestion to combine Constantin with Sugiyama from both the teachings of the prior art and the knowledge of persons of ordinary skill in the art, and has specifically set forth the motivation and suggestion to combine Constantin with Sugiyama.

**Regarding page 13, line 10 to page 14, line 6:** Applicant's arguments are directed to the proposed amendments to the claims, which have not been entered, and not the claims as presently recited.

#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Thompson whose telephone number is 571-272-7441. The examiner can normally be reached on 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

James A. Thompson  
Examiner  
Technology Division 2625

  
22 September 2006



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